

## **REMARKS**

Claims 1-12 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 2, 6, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Inagaki (U.S. Pat. No. 6,748,176) in view of Mizrahi (U.S. Pat. No. 5,982,518). The rejection is respectfully traversed.

The applicant respectfully submits that the Examiner improperly combined Inagaki and Mizrahi to reject the applicant's Claim 1. MPEP § 2143.03 provides that in order to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 1 describes an on-line dispersion compensation device for a wavelength division optical transmission system. The system includes two optical path selectors and at least one chirped grating fiber unit. The chirped grating fiber unit is serially connected between the appropriate ports of the two optical path selectors. The input port of one optical path selector is connected with input optical signal of the device, and

the last stage output port of one optical path selector is connected with the input port of another optical path selector, the last stage output port of another optical path selector outputs the optical signal output of the device. The chirped grating fiber unit further is consisted of two connected chirped grating fibers with same wavelength band and set oppositely.

Inagacki at best discloses an ADD/DROP multiplexer including two optical path selectors. The input port of one optical path selector connects with an input optical signal of the device. A last stage output port of the one optical path selector connects to an optical receiving circuit. An input port of the other optical path selector connects to an optical sending circuit. A chirped grating fiber unit connects between appropriate ports of the two optical path selectors. **Inagacki does not disclose the last stage output port of the one optical path selector connecting to an input port of the other optical path selector.** Inagacki also does not disclose that the chirped grating fiber unit further is consisted of two connected chirped grating fibers with same wavelength band and set oppositely.

Mizrahi does not make up for all the shortcomings of Inagacki.

The examiner referred to FIG. 5 of Ignacki to provide the applicant's last stage output port of the one optical path selector connecting to an input port of the other optical path selector. In doing so the Examiner ignored that Ignacki includes the intervening optical receiving circuit and optical sending circuit. This is a critical omission. A person skilled in the art knows that since the apparatus of Inagacki is an optical ADD/DROP multiplexer, the port T3 of OC55 or OC110 is used for dropping optical signals to local networks, and the port T3 of OC61 or OC114 is used for adding

optical signals from local networks. Thus port T3 of OC55 or OC110 is not, and can not be, connected with the port T3 of OC61 or OC114.

For this reason applicant respectfully submits that Claim 1 is in condition for allowance. With regard to Claims 2 – 12, Applicants note that each ultimately depends from Claim 1, which defines over the prior art, as discussed in detail above. Therefore, Claims 2 – 12 also define over the prior art and reconsideration and withdrawal of the rejections are respectfully requested.

#### **ALLOWABLE SUBJECT MATTER**

The Examiner states that claims 3 and 10-12 would be allowable if rewritten in independent form. Applicant takes the Examiner's statement under advisement and reserves the right to amend these claims into independent forma after the Examiner has considered the remarks above.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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